

REMARKS

Claims 1 and 16 have been rejected under 35 U.S.C. §102(b) as being anticipated by Colnot (U.S. Patent No. 5,613,159). Claims 1-4, 6-7, 10-19, 21-31 and 33-40 have been rejected under 35 U.S.C. §102(b) as being anticipated by Want (U.S. Patent No. 6,008,727). Claims 5, 8-9, 20, 32 and 41-48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Want (U.S. Patent No. 6,008,727). Applicant respectfully traverses these rejections for at least the following reasons.

Examiner's Interview

Applicant wishes to express appreciation for the Examiner's Interview granted and occurring on May 7, 2003.

In the interview, it was agreed that the proposed claim amendments, incorporated herein, would render the 35 U.S.C. §102(b) rejections with respect to Claims 1 and 16 overcome.

More specifically, in the interview, with regard to Want, it was agreed that Want primarily is designed for loss prevention of preferentially mobile objects and definitively for objects for which the location must be tracked, i.e., objects for which the location may not be a known, fixed spatial point. Further, in accordance with Want, such objects must be accessible so that the location of those objects may be assessed.

Thus, as discussed, Want actually teaches away from Applicant's invention, at least in that, as evidenced by the clarifying amendments included herewith, Applicant claims, in relevant

part, “a system for providing instructions for substantially immovable equipment at an inaccessible location” including “a permanently spatially fixed memory device affixed to the equipment.” *See, Amended Claim 1*

Therefore, as discussed in the interview, contrary to the teachings of Want, the memory device of Applicant's invention, and hence the equipment to which it is affixed, is located in a known, inaccessible, permanently spatially fixed location.

Claim Rejections Pursuant to 35 U.S.C. §102(b) as being anticipated by Colnot

Claims 1 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Colnot (U.S. Patent No. 5,613,159). Applicant respectfully traverses these rejections for at least the following reasons:

35 U.S.C. 102(b) recites:

A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Consistently, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent Claim 1, as amended, recites:

1. A system for providing instructions for equipment at an inaccessible location, comprising:

(A) a **permanently spatially fixed** memory device affixed to the equipment, the instructions residing on the memory device; and

(B) a portable memory reading device, separate from the memory device that retrieves the instructions from the memory device and communicates the instructions to a user of said portable memory reading device.

The Examiner agreed, as discussed hereinabove, that the preset claim amendments to Claim 1, incorporated herein, would render the 35 U.S.C. §102(b) rejections with respect to Claims 1 and 16 overcome.

Claim 1 and Dependents

Applicant respectfully submits Colnot teaches that terminal 10 is a stationary device and therefore does not teach Applicant's portable memory reading device as Examiner asserts. In this regard, Colnot teaches "the user must pass close to a payment terminal 10 having a limited geographical working area. This terminal 10, using its transmission means 12, constantly sends out a signal to the portable sets 15 belonging to the different users." *Col. 8, lines 11-15.*

Applicant respectfully submits that at least Applicant's portable memory reading device is thus not anticipated by Colnot.

Further, Applicant submits Colnot teaches that portable set 15 and portable object 30 do not anticipate Applicant's memory device and equipment as set forth in amended Claim 1, and as discussed hereinabove with respect to the interview. Colnot specifically describes a scenario wherein "the user possessing a portable set 15 is actually located in this working area [defined as within a proximity to fixed terminal 10], then the activating means 27 located in the transceiver

device 20 will connect and initialize the portable object 30.” *Col. 8, lines 16-21*. Inapposite, Applicant has claimed “a **permanently spatially fixed** memory device affixed to the equipment, the instructions residing on the memory device.” Additionally, Applicant’s “equipment” is not in an accessible “working area,” as in Colnot, but rather is at an **inaccessible location**. Colnot specifically defines portable set 15 and portable object 30 as being portable, and thus not as being permanently spatially fixed, and thus not as being permanently in an inaccessible location. Applicant thus respectfully submits that at least Applicant’s claimed permanently spatially fixed memory device affixed to the equipment at an inaccessible location, the instructions residing on the memory device, is not anticipated by Colnot.

Colnot thus fails to teach, at least, a permanently spatially fixed memory device affixed to the equipment at an inaccessible location, and a portable memory reading device, and thus Colnot cannot anticipate Claim 1 and the claims dependent therefrom. *See MPEP 2131*. Consequently, Applicant traverses the 35 U.S.C. §102(b) rejection of Claim 1 and the dependents therefrom, deems them overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 1 and the dependents therefrom are in a condition for allowance.

Claim 16 and Dependents

Similarly, independent Claim 16 recites:

16. A system for providing information of at least one dedication at an **inaccessible location**, the information including details concerning reasons for the dedication, comprising:

(A) a **permanently spatially fixed** memory device affixed proximate to the dedication, the dedication information residing on the memory device; and

(B) a portable memory reading device, separate from the memory device that retrieves the dedication information from the memory device and communicates the dedication information to a user of said portable memory reading device.

As stated hereinabove, Applicant respectfully submits that Applicant has claimed “a **permanently spatially fixed** memory device affixed to the equipment, the instructions residing on the memory device.” Additionally, Applicant’s “equipment” is not in an accessible “working area,” as in Colnot, but rather is at an **inaccessible location**. Colnot specifically defines portable set 15 and portable object 30 as being portable, and thus not as being permanently spatially fixed, and thus not as being permanently in an inaccessible location. Applicant thus respectfully submits that at least Applicant’s claimed permanently spatially fixed memory device affixed to the equipment at an inaccessible location, the dedication information residing on the memory device, is not anticipated by Colnot.

Colnot thus fails to teach, at least, a memory device affixed proximate to the dedication and, as discussed hereinabove, a portable memory reading device, and thus Colnot cannot anticipate Claim 16 and the dependents therefrom. *See MPEP 2131*. Consequently, Applicant traverses the 35 U.S.C. §102(b) rejection of Claim 16 and the dependents therefrom, deems them overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 16 and the dependents therefrom are in a condition for allowance.

Claim Rejections Pursuant to 35 U.S.C. §102(b) as being anticipated by Want

Claims 1-4, 6-7, 10-19, 21-31 and 33-40 stand rejected under 35 U.S.C. §102(b) as being anticipated by Want (U.S. Patent No. 6,008,727). Applicant respectfully traverses these rejections for at least the following reasons:

35 U.S.C. 102(b) recites:

A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or an sale in this country, more than one year prior to the date of application for patent in the United States.

Consistently, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See, M.P.E.P. §2131 citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As discussed hereinabove, in the interview, it was agreed that the proposed claim amendments, incorporated herein, would render the 35 U.S.C. §102(b) rejections with respect to Claims 1, 16 and 29 overcome.

Claim 1 and Dependents

Want does not teach the claimed elements of Amendment Claim 1. Further, Applicant submits that Want teaches away from the presently claimed invention. Want teaches that “the electronic tags 32 or 42, 44 and 46 are brought near one or more of the tag readers,

query/response signals 22 and 24 are passed between the electronic tags and the tag reader, and the identification number of the read electronic tag is passed to the computer system.” Want, col. 6, lines 53-58. Examiner, in the present rejection, states that Applicant’s claim is rendered unpatentable because Want’s electronic tags read on Applicant’s memory device. From the quoted portion of Want above, it is clear that Want teaches a theft deterrent system preferentially for goods that are mobile.

On the other hand, the present invention claims “a system for providing instructions for substantially immovable equipment at an inaccessible location,” including “a permanently spatially fixed memory device affixed to the equipment.” *Amended Claim 1*. As may be seen from the relevant portions of amended Claim 1, Applicants invention embodies a substantially stationary memory device affixed to a substantially stationary location or equipment. Applicant submits that Applicant’s spatially fixed memory device affixed to a substantially immovable equipment at an inaccessible location is distinct from Want’s electronic tags that are mobile. Applicant believes this distinction renders Want inapplicable as a reference, as Want teaches away from the present invention.

Applicant further respectfully notes that Applicant's portable reading device as claimed in Claim 1 is distinct from any teachings in Want. Examiner asserts that electronic tag reader 20 as seen and described with respect to Figure 1 teaches Applicant's portable reading device. On the contrary, Want's electronic tag reader is not portable. The disclosure of Want describes an electronic tag reader 20 "connected to a computer system 12, which further includes a local compute 14, database servers 16 and networked computers 18." In the present invention the portable reading device is portable and used by the user to receive the instructions. Want thus

fails to teach, at least, a portable memory reading device and communicating instructions to a user, and thus Want cannot anticipate claim 1. *See MPEP 2131.*

Consequently, Applicant traverses the 35 U.S.C. §102(b) rejection of Claim 1 and the dependents therefrom, deems them overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 1 is in a condition for allowance.

Applicant submits that Want fails to teach, and therefore anticipate, Claims 2-4, 6-7 and 10-15 because of these claims' ultimate dependence on patentably distinct base Claim 1. Applicant submits that each of Claims 2-4, 6-7 and 10-15 are similarly in a condition for allowance.

Claim 16 and Dependents

As recited hereinabove, Claim 16 recites in part a “portable memory reading device” that “communicates the dedication information to a user of said portable memory reading device.” Claim 16 further recites a “permanently spatially fixed memory device.” As set forth hereinabove, with respect to Claim 1, Want fails to teach a “portable memory reading device,” fails to teach the communication of the dedication information to a user, and fails to teach “permanently spatially fixed memory device.” In fact, Want fails to teach any dedication information at all.

Thus, Want cannot anticipate Claim 16 and the dependents therefrom. *See MPEP 2131.* Consequently, Applicant traverses the 35 U.S.C. §102(b) rejection of Claim 16, deems it overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 16 is in a condition for allowance.

Applicant further submits that Want fails to teach, and therefore anticipate, Claims 17-19 and 21-28 because of these claims ultimate dependence on patentably distinct base Claim 16. Applicant submits that each of Claims 17-19 and 21-28 are similarly in a condition for allowance.

Claim 29 and Dependents

As discussed hereinabove with respect to Claims 1 and 16, Claim 29 recites in part a “portable memory reading device” that communicates with a memory device and “receives the plurality of information for display to the user,” and a memory device that is “permanently spatially fixed.” Further, as set forth hereinabove with respect to Claims 1 and 16, Want fails to teach a “portable memory reading device,” further fails to teach the communication with the memory device and receiving the information for display to the user, and further fails to teach a permanently spatially fixed memory device. In fact, Want fails to teach the display of any information at all.

Thus, Want cannot anticipate Claim 29 and the dependents therefrom. *See MPEP 2131*. Consequently, Applicant traverses the 35 U.S.C. §102(b) rejection of Claim 29, deems it overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 29 is in a condition for allowance.

Applicant further submits that Want fails to teach, and therefore anticipate, Claims 30-31 and 33-40 because of these claims ultimate dependence on patentably distinct base Claim 29. Applicant submits that each of Claims 30-31 and 33-40 are similarly in a condition for allowance.

Claim Rejections Pursuant to 35 U.S.C. §103

Claims 5, 8-9, 20, 32 and 41-48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Want (U.S. Patent No. 6,008,727). Applicant respectfully traverses these rejections for at least the following reasons.

35 USC §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Accordingly, MPEP 706.02(j) states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant submits that Want fails to teach, and therefore anticipate or render unpatentable, Claims 5, 8-9, 20 and 32 because of these claims ultimate dependence on patentably distinct base Claim 1, 16, or 29. Applicant submits that each of Claims 5, 8-9, 20 and 32 are similarly in a condition for allowance.

Want does not disclose a “portable reading device,” nor does Want do anything “upon request of the user on the portable memory reading device,” as is claimed in Claim 41. In Want, “the identification number of the read electronic tag is passed to the computer system” when “the electronic tags are brought near one or more of the tag readers.” *See* Want Col. 6, lines 53-58.

Applicant further submits that Want fails to teach, and therefore anticipate or render unpatentable, Claim 41 at least because of the reasons set forth hereinabove with respect to Claims 1, 26 and 29.

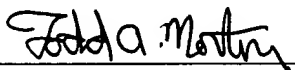
Applicant further submits that Want fails to teach, and therefore anticipate or render unpatentable, Claims 42-48 because of these claims ultimate dependence on patentably distinct base Claim 41. Applicant submits that each of Claims 42-48 are similarly in a condition for allowance.

Conclusion

Applicant respectfully requests reconsideration of the present Application in light of the reasons set forth herein, and a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,

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